

REMARKS

Claim 28 is canceled without prejudice, and therefore claims 16 to 27 and 29 to 31 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to paragraph one (1) of the Office Action, claims 27 and 28 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 27 has been rewritten herein without prejudice, and claim 28 has been canceled without prejudice. It is therefore respectfully requested that the rejections be withdrawn.

With respect to paragraph three (3) of the Office Action, claims 16 to 27 and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by Leen et al., "TTCAN: a new time-triggered controller area network," *Microprocessors and Microsystems Journal* 26 2 (2002), pages 77-94.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

Claim 16 relates to a method for establishing one user corresponding to a transceiver, from multiple users of a data network, as a pilot master for emitting a pilot signal to which other users of the data network can synchronize themselves and provides that the pilot-master-capable user, which detects an external pilot signal on the data network during its checking time interval, enters a temporary slave state.

In this regard, the Leen reference does not identically disclose (or suggest) the feature of *the pilot-master-capable user, which detects an external pilot signal on the data network during its checking time interval, enters a temporary slave state*, as provided for in the context of the presently claimed subject matter. The Leen reference indicates that any node within a set of nodes in a TTCAN can become the time master after a short time-out period, if it has the highest priority as determined by the priority coding of the identifier sub-field of the reference message. Even if the Leen reference may refer to a slave state, it does not distinguish between a temporary slave state and a permanent slave state. In the Leen reference, a slave state may come into existence when another user succeeds in becoming the pilot master.

In contrast to the presently claimed subject matter provides that a user enters a temporary slave state *even before* a pilot master is assumed. In particular, with the presently claimed subject matter, a user in the *temporary* slave state checks during a checking time interval having predefined duration, whether a ping signal is being transmitted in the data network. Also, when a user enters a *permanent* slave state, it checks *continuously* whether an external pilot signal is being transmitted in the data network. Only when the pilot master changes its own status from *temporary* pilot mastership to *permanent* pilot mastership does the user in a temporary slave state enter a permanent slave state. This is done to better ensure that the proper user assumes pilot mastership, and that the process of choosing a proper user for pilot mastership continues, even when a bus system malfunctions.

Therefore, the method according to the presently claimed subject matter is wholly different than that of the Leen reference, which does not identically disclose (nor suggest) the feature of *the pilot-master-capable user, which detects an external pilot signal on the data network during its checking time interval, enters a temporary slave state*, as provided for in the context of the claimed subject matter.

It is therefore respectfully submitted that claim 16 is allowable as are its dependent claims 17 to 26.

Claim 27 and claim 29 relate to a computer readable medium having a computer program executable on a computer, and a data network having multiple users, respectively, but otherwise includes features like that of claim 16. Accordingly, claims 27 and 29 are allowable for essentially the same reasons as claim 16.

Withdrawal of the rejections of these claims is therefore respectfully requested.

With respect to paragraph five (5) of the Office Action, claim 30 was rejected under 35 U.S.C. § 103(a) as unpatentable over Leen et al. in view of “Manis et al.”, U.S. Patent Application Publication No. 2003/0133473.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 30 depends from claim 29 and is therefore allowable for essentially the same reasons as claim 29, since the secondary “Manis” reference does not cure--and is not asserted to cure-- the critical deficiencies of the primary “Leen” reference.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be

supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejection of claims 30 is therefore respectfully requested.

Accordingly, all of pending claims 16 to 27, 29 and 30 are allowable.

CONCLUSION

In view of the foregoing, all of pending claims 16 to 27, 29 and 30 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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